REMARKS

Claims 1-47 are pending in the above-reference patent application. No claims are currently amended, cancelled, or added by this response. The above-referenced patent application has been reviewed in light of the Final Office Action, dated February 8, 2007, in which: claims 1-47 stand rejected under 35 USC § 102(e) as being anticipated by US Patent Publication No. 2002/0059425 of Belfiore et al. (hereinafter, Belfiore). This rejection by the Examiner of these claims on this ground is respectfully traversed.

As is well-established, to make a prima facie rejection under 35 USC 102, the Examiner must provide a prior art document that teaches each and every element and limitation of the rejected claim or claims. If even a single limitation is not present in the cited document, then the Examiner has failed to make a proper rejection under 35 USC 102.

Regarding the substance of the Examiner's rejections, we begin with claim 1. Regarding this claim, the document cited by the Examiner does not make out a prima facie rejection under 35 USC § 102 because Belfiore does not disclose each and every element of claim 1. As just one example, Belfiore does not disclose "supplying an asset list over said network to a user device, said user device including a client process" as recited by claim 1. The Examiner contends that this aspect of Assignee's claimed subject matter is taught by paragraph [0123] to [0126] of Belfiore. Assignee respectfully disagrees with this assertion.

Assignee respectfully asserts that the cited portions of Belfiore do not teach anything relating to an asset list, as that term is used in Assignee's filing. For example, the cited portions of Belfiore discuss a system wherein "[c]onsumers of events, such as, by way of example, event store 622, perform inferences 624 from sets of low-level (atomic events 606) or higher level events 612 and take actions based on these inferences. The inferences 624 can range from the simple retransmission of the information to logical, Bayesian, and decision-theoretic inferences." Assignee respectfully asserts that it is clear from the cited portion of Belfiore that this document does not teach "supplying an asset list over said network to a user device, said user device including a client

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process," as recited by Assignee's claim 1. While claimed subject matter is, of course, not limited by the specification, illustrative examples from the present application may be useful for illuminating distinctions between Assignee's claimed subject matter and the cited portions of Belfiore. For example, paragraph [0034] of the present application states that "[a]n asset list comprises information related to the media assets to be downloaded to the client device." For additional example, paragraph [0055] of the present application states that "[i]n one implementation, the assets included in the cache are dictated by an asset list provided by a content provider." For further example, paragraph [0056] of the present application states that "[a] client is allowed to be associated with more than one asset list, so that many service providers or multiple business units of one service provider can separately maintain their own asset lists and make use of the same client to manage the downloads." Again, it should be noted that the above examples are provided for illustrative purposes only and that claimed subject matter is, of course, not limited to the examples provided. Again, Assignee respectfully asserts that the cited portion of Belfiore does not teach "supplying an asset list over said network to a user device, said user device including a client process," as recited by Assignee's claim 1. Accordingly, Assignee respectfully requests that this ground for rejection be withdrawn.

For further example, Assignee respectfully asserts that Belfiore also does not teach "delivering said asset over said network to said user device if a predetermined constraint is satisfied," as recited by Assignee's claim 1. The Examiner contends that this aspect of Assignee's claimed subject matter is taught by paragraphs [0127] and [0128] of Belfiore. Assignee respectfully disagrees with this contention as well. The portions of Belfiore do not even mention delivering an asset and, therefore, cannot teach this aspect of Assignee's claimed subject matter. For example, the cited portion of Belfiore states that "[e]vent schema is a collection of class descriptions and the relationships among these classes that define physical event structure" and that "[g]iven this structure, the pattern language is able to use both instance data and schema information in order to capture higher-level semantics and rules with which to create derivative events." The cited portion of Belfiore simply does not teach or suggest "delivering said asset over said network to said user device if a predetermined constraint is satisfied," as recited by Assignee's claim 1. For at least this reason, Assignee respectfully requests that this rejection be withdrawn.

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Furthermore, Assignee would like to again point out that Belfiore does not appear to be directed to the problem addressed by Assignee's claimed subject matter. Given the differences between the subject matter of Belfiore and Assignee's claimed subject matter, it is respectfully asserted that the Examiner has misconstrued Belfiore and that Belfiore is does not anticipate Assignee's claimed subject matter under 35 USC § 102(e). For example, Belfiore states that "the present invention, [ ] is a distributed computing platform that facilitates more Internet-based collaboration and more inter-Web site communication." See Belfiore, paragraph [00015), lines 2-4. Assignee respectfully asserts that Belfiore does not teach anything related to Assignee's claimed subject matter. In light of this, it is respectfully asserted that the Examiner's rejection of these claims has been traversed. It is, therefore, respectfully requested that the Examiner's rejection on these grounds be withdrawn.

In response to Assignee's earlier arguments on this subject, the Examiner contends that "if the prior art structure is capable of performing the intended use, then it meets the claim." Assignee respectfully asserts that the Examiner is incorrect in contending that the structure in the cited document is capable of performing the intended use without modification. Rather, here, inventive modifications would be required. If, instead, the Examiner is asserting that the cited document *inherently* teaches Assignee's claimed subject matter, then Assignee respectfully asserts that the Examiner is not correct in this regard as well.

As is well-settled law, to establish inherency, "extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). See also MPEP § 2163.07(a). More recently, the Federal Circuit has stated that to establish inherent anticipation, it must be shown that "the disclosure [of the cited document] is sufficient to show that the natural result flowing from the operation as taught [in the cited document] would result in the claimed [subject matter]." SmithKline Beecham Corp. v. Apotex Corp., 403 F3d 1331, 1343 (Fed. Cir. 2005). The Examiner has failed to show that the natural result flowing from the operation disclosed in

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Belfiore would provide Assignee's claimed subject matter. Perhaps more importantly, it is not the case that the natural result flowing from the operation disclosed in Belfiore would provide Assignee's claimed subject matter. It is, therefore, respectfully requested that the Examiner's rejection on this ground be withdrawn.

With regard to the Examiner's contention that Assignee's previous remarks do not comply with 37 CFR 1.111(b) and 37 CFR 1.111(c), Assignee respectfully disagrees with the Examiner's contention. However, regardless, these contentions are mooted in light of this filing in any event.

The remaining rejected claims all patentably distinguish from Belfiore on at least on the same and/or a similar basis as claim 1. Thus, it is also requested that the Examiner withdraw the rejection of those claims on this ground as well.

For at least the reasons above, Assignee respectfully submits that claims 1- 47 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed to be more than sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

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Attorney Docket No. 038.P006
Serial No. 10/632,003
Filed: July 30, 2003

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3130.

Respectfully submitted,

Dated: ___April 9, 2007_____   _____/Steven J. Munson/_____
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